**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | | |
|---|---|---|
| Applicant: Andrew E. Fano et al. | ) | |
| Serial No. 10/027,188 | ) | Art Unit: 2686 |
| Filed: December 20, 2001 | ) | Examiner: Rafael Perez Gutierrez |
| For: DETERMINING THE CONTEXT OF SURROUNDINGS | ) | |

**DECLARATION UNDER 37 C.F.R. § 1.131**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22314-1450

Sir:

I, Andrew E. Fano, a citizen of the United States of America residing at 6 Plymouth Court; Lincolnshire, Illinois 60069, do hereby declare that:

1. I am one of the joint inventors of the subject matter described and claimed in U.S. Patent Application No. 10/027,188 (collectively, "the Invention"), filed in the United States of America on December 20, 2001, titled "Determining the Context of Surroundings."

2. Mr. Scott W. Kurth is the other joint inventor of the Invention.

3. I conceived the Invention with Mr. Scott W. Kurth prior to May 15, 2001 while employed by Accenture, LLP ("Accenture") as indicated by Exhibit A. Exhibit A evidences a redacted copy of an e-mail I sent to IP legal personnel at Accenture containing an Intellectual Property Questionnaire ("IP Questionnaire") I completed prior thereto. The IP Questionnaire is a form used by Accenture employees and contractors to, among other things, report discovery of a new technological innovation or invention. Language only tangentially related to the conception of the Invention has been redacted to preserve, among other things, the confidentiality of Accenture's business practices and the privacy of Accenture's employees and contractors. Other redacted language relates to confidential material protected by the Attorney-Client Privilege and/or the Attorney Work Product Doctrine. The remaining language clearly establishes the conception of the Invention by Mr. Scott W. Kurth and me.

For instance, under subpart I titled "Innovators," my name and the name of Mr. Scott W. Kurth are listed as innovators or inventors of the Invention. Under subpart III titled "Description of Innovation," the Invention and obvious variants thereof are described in both general and specific terms. At least the following language and citations adequately support the above:

— "It remains difficult, however, for mobile service providers to detect the objects in the user's environment that might inform and aid the service to be delivered. For example, it could be useful to detect what service channels might be present at the location to deliver the context—such as a kiosk. Or it would be useful to identify what equipment is available for the use of the customer." (Exhibit A, IP Questionnaire, § III, ¶ 3).

— "A person's short-range wireless enabled mobile device can discover and identify the nearby short range wireless-enabled equipment. This information is then relayed back to a service provider, possibly through an intermediary." (Exhibit A, IP Questionnaire, § III, ¶ 3).

— "In addition to merely identifying nearby equipment, the customer's mobile device could be used to monitor their activities." (Exhibit A, IP Questionnaire, § III, ¶ 3).

— "Devices would use short-range wireless to 'broadcast' their activities …." (Exhibit A, IP Questionnaire, § III, ¶ 3).

— "Mobile devices would record the activities of short-range wireless [equipped] devices and locations within their range. At any given time this could be used to inform [a] remote service provider of what is going on." (Exhibit A, IP Questionnaire, § III, ¶ 3).

— "The ability to track the events a person or piece of equipment is exposed to enables services that notice dangerous situations that arise over time [is obtained] …." (Exhibit A, IP Questionnaire, § III, ¶ 4).

— "The ability to sense how facilities and their equipment are used, traffic patterns, regional differences, etc [is obtained] …." (Exhibit A, IP Questionnaire, § III, ¶ 4).

— "More generally, the ability to monitor how equipment is used provides greater visibility within supply chain." (Exhibit A, IP Questionnaire, § III, ¶ 4).

Accordingly, the contents of Exhibit A establish the possession by Mr. Scott W. Kurt and me of the whole Invention, one or more obvious variants thereof or something falling within the claims.

4. Individually and collectively, Mr. Scott W. Kurth and I diligently worked toward a reduction to practice from at least a date prior to May 15, 2001 to at least December 20, 2001. Exhibit A and the following statements based on information and belief adequately

support this factual contention. Language in the Exhibit A that is only tangentially related to my due diligence or the collective due diligence of Mr. Scott W. Kurth and me has been redacted to preserve, among other things, the confidentiality of Accenture's business practices and the privacy of Accenture's employees and contractors. Other redacted language relates to confidential material protected by the Attorney-Client Privilege and/or the Attorney Work Product Doctrine. The remaining language and statements, alone and in combination with the declaration of Mr. Scott W. Kurth, executed on April 27, 2006, clearly establish both my due diligence and the collective due diligence of Mr. Scott W. Kurth and me.

— Exhibit A further contains an e-mail I received on March 5, 2001 from a senior paralegal and I/P administrator at Accenture addressed to Mr. Scott W. Kurth and me. The body of the e-mail acknowledges receipt of the IP Questionnaire by Accenture IP legal personnel. The e-mail further establishes that the case was assigned to Mr. John Rollins, an Accenture patent attorney, for further review.

— On July 24, 2001, I received an e-mail addressed to Mr. Scott W. Kurth and me from Mr. Joseph P. Krause, outside counsel with the law firm of Vedder, Price, Kaufman & Kammholz, P.C.. The e-mail included a second draft of several claims directed toward the Invention as an attachment. Based on the contents of this e-mail and based on information and belief, Accenture contracted with outside counsel on a date between February 12, 2001 and July 24, 2001 to draft a patent application regarding the Invention ("the Patent Application"). Thus, the July 24, 2001 communication further substantiates that at least between the dates of February 12, 2001 and July 24, 2001 Mr. Scott W. Kurth and I, through our individual and collective resources, caused the advancement of prosecution of the Invention before the U.S. Patent & Trademark Office.

— On August 9, 2001, I received an e-mail from Mr. Joseph P. Krause addressed to Mr. Andrew E. Fano and me. The e-mail included a first draft of the Patent Application as an attachment. Mr. Joseph P. Krause, in the body of the communication, invited comments to this draft.

— On August 10, 2001, I received an e-mail from Mr. Joseph P. Krause addressed to Mr. Andrew E. Fano and me indicating that he revised the first draft of the Patent Application in view of our comments. The e-mail included a second draft of the Patent Application as an attachment.

— On October 9, 2001, I received an e-mail from Mr. Joseph P. Krause indicating that outside counsel made revisions to the second draft of the Patent Application at least based on conversations with Mr. John Rollins. The communication included a third draft of the Patent Application and was intended for my review as a joint inventor of the Invention.

— On October 11, 2001, I sent an e-mail to Mr. Scott W. Kurth indicating that I made revisions to the third draft of the Patent Application. Based on information and belief, Mr. Scott W. Kurth received my e-mail dated October 11, 2001 and discussed inventor comments with Mr. Joseph P. Krause. Based on additional information and belief, Mr. Joseph P. Krause received these comments and began making revisions for the production of a fourth daft of the Patent Application sometime thereabout.

— I took a personal vacation on or about the second and/or third week of October 2001.

— On November 6, 2001, I executed an assignment before a notary republic. Based on information and belief, Mr. Scott W. Kurth also executed the same assignment before a notary republic on November 6, 2001. The Assignment provides for the transfer of the entire right, title and interest in and to the Invention and any improvements thereto from Mr. Scott W. Kurth and I to Accenture Global Services GmBH.

— Based on information and belief, in-house counsel at Accenture reviewed a final draft of the Patent Application on or before December 20, 2001 in the normal course of business.

— Based on information and belief, in-house counsel at Accenture executed a power of attorney on or before December 20, 2001 in the normal course of business authorizing Mr. Joseph P. Krause and the law firm of Vedder, Price, Kaufman & Kammholz, P.C. to file and prosecute the Patent Application before the U.S. Patent & Trademark Office.

— Based on information and belief, Mr. Joseph P. Krause and the law firm of Vedder, Price, Kaufman & Kammholz, P.C. filed the Patent Application with the United States Patent & Trademark Office on or about December 20, 2001.

Accordingly, the above facts and statements illustrate that both Mr. Scott W. Kurth and I, individually and collectively, worked toward the reduction of practice of the Invention from a date prior to May 15, 2001 to at least December 20, 2001. The above facts further illustrate that in-house counsel at Accenture, outside counsel at Vedder, Price, Kaufman & Kammholz, P.C., Mr. Scott W. Kurth and I, individually and collectively, diligently worked toward the reduction of practice of the Invention from a date prior to May 15, 2001 to at least December 20, 2001.

5. I hereby declare that all statements made herein are of my own knowledge, are true and that all statements made on information and belief are believed to be true; and I further declare that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued therefrom.

Dated: 4/26/06

Andrew E. Fano

Exhibit A

[redacted]

03/05/2001 02:29 PM

To: Scott Kurth[redacted] Andrew E. Fano[redacted]
cc: John F. Rollins[redacted]
Subject: New Disclosure [redacted] for Method to Detect User Context

Hello, Andrew and Scott:

Thank you for submitting the attached I/P Questionnaire for "Method of Using Short Range Wireless Technologies to Detect User Context." We have assigned your disclosure docket number [redacted], and John Rollins is the Accenture patent attorney assigned to review it. John is located in [redacted], and he will be contacting you to discuss this disclosure. If you have any questions, please feel free to give John or me a call. John can be reached at [redacted], and my telephone number is [redacted].

[redacted]
Senior Paralegal and I/P Administrator
[redacted]

---

**Andrew E. Fano**
[redacted]

To: IP Legal Mailbox[redacted]
cc:
Subject: IP Submission

## Intellectual Property Questionnaire

>> Please note that you must use the "Forward" or "Reply With History" buttons above to begin the questionnaire. **Please forward to "IP Legal**

## I. Innovators

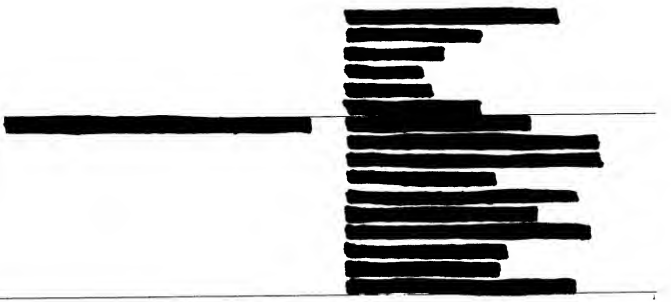
| Questions | Responses |
|---|---|
| [redacted] | |

Andrew E. Fano

[redacted]

| | | |
|---|---|---|
| Scott Kurth | [redacted] | |

## II. Innovation Information



## III. Description of Innovation

3. Provide a brief explanation of the innovation (e.g. what is the innovation, what problem does it address).

The next generation of mobile services will be highly dependent on the ability to sense a customer's context. Much attention has been given to the ability to detect location, for example. It remains difficult, however, for mobile service providers to detect the objects in the user's environment that might inform and aid the service to be delivered. For example, it could be useful to detect what service channels might be present at the location to deliver the context - such as a kiosk. Or it

would be useful to identify what equipment is available for the use of the customer.

**I Cheap "Machine Vision" for Remote Service Providers**
This invention is a process for addressing this problem. A person's short-range wireless enabled mobile device can discover and identify the nearby short range wireless-enabled equipment. This information is then relayed back to the service provider, possibly through an intermediary.

The key innovation is to use short-range wireless (e.g. Bluetooth) not necessarily to interact with nearby devices but as a form of "machine vision" enabling remote providers to "see" certain aspects of a customer's context.

**II Remote Sensing of Events**
In addition to merely identifying nearby equipment, the customer's mobile device could be used to monitor their activities. In this scheme:

1. **Devices Broadcast their Activities**
Devices would use short-range wireless to "broadcast" their activities (e.g. an X-Ray machine broadcasting that it is performing a chest xray, a mixer broadcasting the chemicals being mixed, a truck announcing what it is delivering, a conference room broadcasts information about the current meeting or its schedule, etc..)

2. **Mobile Devices Monitor Log What they "witness".**
Mobile devices would record the activities of short-range wireless equippoed devices and locations

within their range. At any given time this could be used to inform remote service provider of what is going on. Over time a log of such events constitutes a history of what the device (and more importantly its owner) has witnessed (i.e. been near ~30 feet for bluetooth).

4. Describe the application, potential re-usability and business rationale for patenting this innovation. Please attach any existing documents which more fully describe the innovation.

We are at the beginning of what is predicted to be an explosion of short-range wireless equipped devices. Bluetooth is the most often mentioned standard. [redacted]

Applications most often mentioned are eliminating wires and giving devices internet access. The inventions listed here are attempting to identify next generation, and less obvious applications of this technology, once the devices arrive. [redacted]

There are countless applications for this approach including in the following areas:

[redacted]

Remote Service providers need to "see what is going on" with a customer so that they can personalize their offerings. Location is just one important piece of the context and is already generating tremendous interest and investment. [redacted]

[redacted]

**Safety**
The ability to track the events a person or piece of equipment is exposed to enables services that notice dangerous situations that arise over time (e.g. overexposure to harmful events, need for servicing, use of inappropriate equipment, etc.)

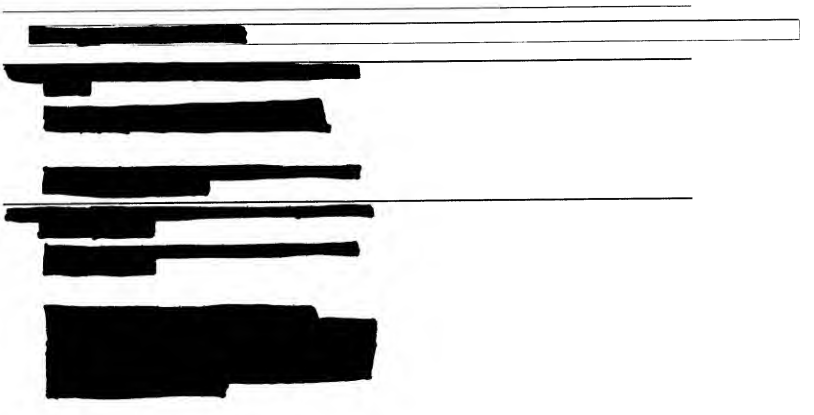
**Auditing and Compliance**
The ability to log who and what was in proximity to each other creates the ability to monitor and demonstrate compliance with various kinds of regulations, as well as notice the need to address a situation. It provides an auditable record of what transpired. Unlike today where we can either do spot checks of a physical facility or inspect how a facility is used in

**Knowledge Management**
The ability to sense how facilities and their equipment are used, traffic patterns, regional differences, etc, constitutes a treasure trove of heretofore largely unavailable information to corporations.

**Supply Chain Integration**
The ability for machinery to notice when the inputs they process come within range enables them to automatatically initiate necessary preprocessing (e.g warmup) and reduce lag times. More generally, the ability to monitor how equipment is used provides

greater visibility within the supply chain.

[redacted] the ability to sense what is going on with a student remotely can enable far more personalized instruction.



[redacted]

[redacted]

## V. Conception of Innovation

7. When was this innovation conceived? [redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]